

Remarks/Arguments

The preceding amendments and following remarks are submitted in response to the non-final Office Action mailed April 21, 2004, setting a three-month shortened statutory period for response ending July 21, 2004. With this Amendment, Applicants have cancelled claims 1-4, and have added newly presented claims 32-51, which Applicants submit are readable upon the elected species of Figures 1-3. Reconsideration, examination, and allowance of all pending claims are respectfully requested.

In paragraph 3 of the Office Action, the Examiner objected to the drawings under 37 C.F.R. § 1.84(p)(5), stating that the reference sign “80” referred to in the specification as a “limiter” is not included in the drawings. The Examiner states that a proposed drawing correction or corrected drawings are required in response to the Office Action to avoid abandonment of the application.

In response to the Examiner’s objection, Applicants have amended the specification to change all instances of reference number “80” to “58”, which is already contained in Figure 3 of the drawings. Applicants respectfully submit that these amendments to the specification overcome the Examiner’s objection to the drawings under 37 C.F.R. § 1.84(p)(5).

Also included herewith are formal drawings to be filed for the present Application. Applicants submit that these formal drawings are in compliance with the standards for drawings set forth in 37 C.F.R. § 1.84, and contain no new matter.

**35 U.S.C. § 102 Rejections**

On page 3 of the Office Action, the Examiner rejected claims 1-4 under 35 U.S.C. § 102(e) as being anticipated by *Brady et al.* (U.S. Patent No. 6,565,591).

The Examiner states that *Brady et al.* disclose a filter system that includes an elongate shaft, a filter disposed on the distal end of the shaft, a first tapered portion having an apex at its distal end and a base diameter at its proximal end, and a second tapered portion. The Examiner further states that the base diameter of the first tapered portion is similar to an inner diameter of a retrieval sheath.

In response thereto, Applicants have cancelled claims 1-4, and have added newly presented claims 32-51, which Applicants submit are patentable over the cited prior art. In particular, Applicants have added independent claim 32, which recites the limitation that the filter assembly includes a first tapered portion defining a base diameter, an apex, and a first included angle; and a second tapered portion *extending proximally from the base diameter of the first tapered portion* and defining a first diameter, a second diameter, and a second included angle different from the first included angle. Support for these amendments can be found, for example, in Figures 1-2 of the drawings, which show the second tapered portion (64) extending proximally from the base diameter (68) of the first tapered portion (62).

Unlike the filter assembly recited in independent claim 32, the embolic protection device 1 disclosed by *Brady et al.* does not include a second tapered portion extending proximally from the base diameter of a first tapered portion having a first diameter at the base diameter and a second diameter greater than the first diameter. In *Brady et al.*, the distal end (47) of the filter body (41) extending proximally from the base diameter of the guide olive (57) is cylindrical in shape, and thus does not form a tapered portion of the device (1). This can be clearly seen in Figure 1 of *Brady et al.*, which shows the distal end (47) of the filter body (41) having a substantially uniform diameter extending

Application Serial No. 10/044,368  
Reply to Office Action dated April 21, 2004

proximally from the base of the guide olive (57) to the distal outlet end of the filter body (41) (*i.e.* the location labeled “first diameter of second tapered portion in Attachment #1 of the Examiner’s Office Action). Since *Brady et al.* fail to disclose or suggest a second tapered portion extending proximally from the base diameter of a first tapered portion, Applicants respectfully assert that claims 32, 52, and 70 are patentable over *Brady et al.*

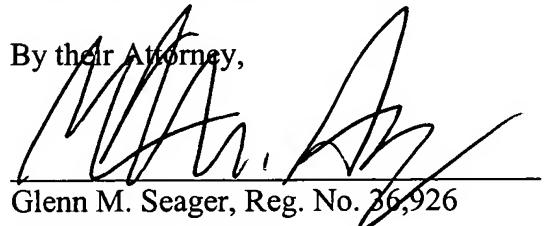
Because independent claims 32 and 52 are allowable, claims 33-51 and 53-69 are also allowable for the reasons stated above, and since they add other significant elements to distinguish them from the cited prior art.

In view of the foregoing, Applicants submit that all pending claims are in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner would like to discuss the Application or its examination, please contact the undersigned at (612) 677-9050.

Respectfully submitted,

THOMAS BROOME ET AL.

By their Attorney,

  
Glenn M. Seager, Reg. No. 36,926

Customer No. 28075

CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800

Minneapolis, MN 55403-2402

Telephone: (612) 677-9050

Facsimile: (612) 359-9349

Date: June 15, 2004